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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/252,842	02/19/1999	CHARI STYLLI	AUROBIO.014A	4954

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EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 04/09/2003

1/3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/252,842

Applicant(s)

STYLLI ET AL.

Examiner

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The cancellation of claims 10-12 is acknowledged and has been entered into the record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Davis, Jr. *et al* (USP 5,647,724).

Davis, Jr. *et al* teach a substrate transport apparatus with dual substrate holders. The substrate transport apparatus 12 (e.g. automated chemical retriever) comprises two substrate holders 22, 23, which are coupled to and can move in unison with each other. One of the substrate holders can be retrieving a substrate from the a storage module while the other acts as a buffer and temporarily holds the substrate before transferring to a process chamber (summary of invention section).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 20-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelso *et al* (WO 93/12431).

Kelso *et al* teach a system for conducting analytical procedures on multi-well plates. The system comprising a plurality of modular processing stations. The system further comprises a computer controlled chemical storage module 22 for storing a plurality of multi-well plates 12. The plates comprises a set of drug candidate compounds in the addressable wells 18 (Figs. 9, 10). The controller provides an automated robotic retriever 20 (page 23) to remove a subset (e.g. single multiwell plate) of said addressable chemical wells from the chemical storage module 22 (page 18), and next, delivering the removed multiwell plate to a bi-directional conveyor 166 (page 41, last paragraph). The conveyor then delivers the multi-well plate to an automated liquid handler 277, which aspirates compounds from less than all of the wells in the multiwell plate (page 53). The multiwell plate can be transported by the robot 20 to one of the other plurality of liquid handlers (e.g. wash dispensing station 30 or reagent dispensing station 26). The system is controlled by a master control module 16 which is pre-programmed (e.g. programmable) with various modes to control the appropriate mechanisms of the processing stations 22 to 36, e.g. aspirates compounds from less than all of the wells in the multiwell plate

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(page 35, section C and page 53). Note: the conveyor mechanisms include an access support surface, i.e. buffer, 92 situated at the ingress/egress of the storage module. The access support can includes a mechanism for moving, or sorting, the multi-well plate on the support surface independent of the robot 20 (page 29).

Kelso *et al* do not specifically recite the storage module containing at least approximately 3000 multi-well plates or the plates containing approximately 100,000 addressable locations. However, would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have constructed the storage module of Kelso *et al* which is capable of holding at least 3000 multi-well plates or multi-well plates containing approximately 100,000 addressable locations in order to increase processing throughput. Additionally, it has been held that the mere duplication of parts has no patentable significance unless a new and unexpected is produced. *In re Harza*, 124 PQ 378 (CCPA 1960).

7. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelso *et al* (WO 93/12431) in view of Davis, Jr. *et al* (USP 5,647,724).

Kelso *et al* as discussed above, fail to teach a buffer coupled to and moving with the chemical retriever. Davis, Jr. *et al* as previously discussed, do disclose a substrate transport apparatus 12 (e.g. automated chemical retriever) comprise two substrate holders 22, 23, which are coupled to and can move in unison with each other. One of the substrate holders can be retrieving a substrate from the a storage module while the other acts a buffer and temporarily holds the substrate before transferring to a process chamber (summary of invention section, Fig. 1).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the automatic analyzer of Kelso *et al* the automated retrieval unit, as taught by Davis, Jr. *et al*. Davis, Jr. *et al* disclose the positioning of these two holders to act on same side of the apparatus 12 can speed up throughput by allowing the holders to move along substantially parallel paths.

Response to Arguments

8. Applicant's arguments filed January 27, 2003 have been considered but have not been found persuasive. In response to the previous rejection of claims 1-3, 20-21 and 24 under 35 U.S.C. 103(a) as being unpatentable over Kelso *et al* (WO 93/12431), Applicant argues Kelso *et al* do not anticipate the instant invention as it teaches the removal of specimens from "all" of the test tubes 186. Additionally, Applicant argues that there is nothing programmable in the sequence or selection of the sample. Examiner does not agree, since Examiner does not believe the test tube rack 184 is the most analogous to the multiwell plate of the instant invention. In fact, the rejection does not address the test tube rack 184 at all. The rejection cites the **multi-well plates 12** for the teaching of the multi-well plate comprising set of drug candidate compounds in the addressable wells 18. The controller providing an automated robotic retriever 20 (page 23) to remove a subset (e.g. single multiwell plate) of said addressable chemical wells from the chemical storage module 22 (page 18). Next, delivering the removed multiwell plate to a bi-directional conveyor 166 (page 41, last paragraph). The conveyor then delivers the multi-well plate to an **automated liquid handler 277**, which aspirates compounds from **less than all** of the wells in the multiwell plate (page 53). The multiwell plate can be transported by the robot 20 to one of the other plurality of liquid handlers (e.g. wash dispensing station 30 or reagent

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dispensing station 26). The system is controlled by a master control module 16 which is pre-programmed (e.g. programmable) with various modes to control the appropriate mechanisms of the processing stations 22 to 36, e.g. aspirates compounds from less than all of the wells in the multiwell plate (page 35, section C and page 53). Applicant does seem agree the probe 277 to be "programmable", see Response filed January 27, 2003, page 5, 1st full paragraph.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., retrieve and handle **either** (a)....**or** (b) the sample from a subset of chemical wells within the at least one multi-well) is presented in an alternative expression, therefore the reference need only perform the function under (a) or (b), not both.

Conclusion

9. No claims allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Kathryn Bex

P. Kathryn Bex
Patent Examiner
AU 1743
April 4, 2003

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